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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,375	06/18/2001	Scott Bonneau	T00087	1781
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EXAMINER COLBERT, ELLA				
ART UNIT 3696		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tmunoz@hamiltontertile.com

Office Action Summary

Application No.

09/884,375

Applicant(s)

BONNEAU ET AL.

Examiner

Ella Colbert

Art Unit

3696

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-22, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Claims 11-22, 24, and 25 are pending. Claims 13 and 16-20 have been amended in the communication filed 5/30/08 entered as Response After Ex Parte Quayle Action.
2. The Allowance of September 29, 2008 is hereby withdrawn in view of the Examiner's request for amendments to be made to the claims in order to allow the application and no response was received to the request. Claims 11-22, 24, and 25 will be examined as set forth here below.

Claim Objections

Claim 12 is objected to because of the following informalities: Claim 12 is objected to for the acronym "ID". The acronym should be written as follows: identification (ID). Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to

a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

In this particular case regarding the first test, in performing the steps of the claimed subject matter, there is no requirement that a machine be used, thus the claims are not considered sufficiently tied to another statutory class.

Claim 21 is considered non-statutory because the program instructions stored on the storage medium are not computer executable.

Claims 12-20, 22, 24, and 25 are also rejected because they depend from a rejected claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-22, 24 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 11 reciting generating each of the plurality of hierarchies, wherein ... comprises: establishing a set of rules for the primary hierarchy, wherein ...; including

the leaf node, for each leaf node in the primary hierarchy, in the custom browse hierarchy ...” are not found in Applicants’ Specification. Claim 11 also recites “including the leaf node, for each leaf node in the primary hierarchy, in the custom browse hierarchy ...; including the ancestor node, for each ancestor node in the primary hierarchy, in the custom browse hierarchy ...”. These claim limitations are redundant reciting “including the leaf node, for each leaf node” and including the ancestor node, for each ancestor node”. These limitations would be better recited as “including each leaf node in the primary hierarchy, ...” and “including for each ancestor node in the primary hierarchy, ...”. Claim 21 has a similar problem. Also the “computer-readable storage medium and program instructions stored on the storage medium are not found in Applicants’ specification. Claim 11 recites “pared version of the primary hierarchy” which is not found in the Specification. Page 5, lines 7-9 recites “Each custom browse hierarchy would have a scope that is pared down from the primary hierarchy and typically (although not necessarily) coextensive with the scope of its associated custom version of the catalog”. The term “pared” by definition is defined as “to trim off an outside, excess, or irregular part of”. Claim 21 has a similar problem.

Claims 12-20, 22, 24, and 25 are also rejected for their dependency from a rejected claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11, recites "establishing a set of rules for the primary hierarchy, wherein each rule ..., if any, of the leaf node, ... each ancestor node, if any, of the leaf node, wherein the constraints of each ..., if any, of the leaf node in the aggregation of constraints are logically aggregated together;". The "if any" is not a positive recitation in the claim limitations because the claim limitations do not say there are ancestor nodes of the leaf node in the aggregation. It is unclear, vague and indefinite whether any of the leaf nodes exist and whether any ancestor nodes exist. The wording of these claim limitations in claims 11 and 21 are very confusing as written.

Claim 11 recites in lines 28-30 "of the ancestor node is included in the custom browse hierarchy and otherwise excluding the ancestor node from the custom browse hierarchy". This claim recitation is very vague and unclear as written. This recitation sounds redundant because if the ancestor node is already excluded from the custom browse hierarchy" why is it necessary to exclude this node again?

Claim 21 has a similar problem.

Claims 11 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements in claim 11 are: after "of" and before "hierarchies" the omitted elements are "custom browse". Claim 21 has a similar problem.

Claim 12-20, 22, 24, and 25 are also rejected for their dependency from a rejected claim.

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,933,599) Nolan in view of (US 6,460,025) Fohn et al, here after Fohn.

Claims 11 and 21. Nolan discloses, A method and a computer program product for generating, from a primary hierarchy of items, a plurality of custom browse hierarchies for unique subsets of the items in the primary hierarchy, wherein the primary hierarchy comprises leaf nodes and one or more ancestor nodes of one or more of the leaf nodes, each leaf node defines a set of one or more items that meets constraints of the leaf node and each ancestor node, if any, of the leaf node, and the constraints of each leaf node and each ancestor node, if any, of the leaf node comprise one or more attribute names and one or more attribute values, the method comprising:

generating each of the plurality of hierarchies, wherein generating each of the plurality

of hierarchies comprises: establishing a set of rules for the primary hierarchy, wherein each rule in the set of rules is associated with one of the leaf nodes and each ancestor node, if any, of the leaf node, and each rule comprises an aggregation of constraints specified by the leaf node and each ancestor node, if any, of the leaf node, wherein the constraints of each leaf node and each ancestor node, if any, of the leaf node in the aggregation of constraints are logically aggregated together (col. 8, lines 1-45 and fig. 2 (204) and (210)).

Nolan failed to disclose, identifying a rule subset of the set of rules, wherein each rule in the rule subset has constraints that are met by at least one of the items in the unique subset of items and including the leaf node, for each leaf node in the primary hierarchy, in the custom browse hierarchy if the rule associated with the leaf node is included in the subset of rules and excluding the leaf node from the custom browse hierarchy if the rule associated with the leaf node is not included in the subset of rules.

Fohn discloses, identifying a rule subset of the set of rules, wherein each rule in the rule subset has constraints that are met by at least one of the items in the unique subset of items (col. 8, lines 25-65, col. 9, lines 7-45, and col. 18, line 17- col. 19, line 12) and including the leaf node, for each leaf node in the primary hierarchy, in the custom browse hierarchy if the rule associated with the leaf node is included in the subset of rules and excluding the leaf node from the custom browse hierarchy if the rule associated with the leaf node is not included in the subset of rules (col. 4, lines 20-37 and col. 18, lines 39-54). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Fohn in Nolan

because such an incorporation would allow Nolan to have "a user's selection of a node to act as a constraint contributing to the boundary of the feasible space where the boundary outlines the eligible entities that reside in the feasible space".

Nolan further discloses, including the ancestor node, for each ancestor node in the primary hierarchy, in the custom browse hierarchy if at least one leaf node of the ancestor node is included in the custom browse hierarchy and otherwise excluding the ancestor node from the custom browse hierarchy (col. 7, lines9-48); and representing the custom browse hierarchy by all the included leaf nodes and included ancestor nodes, if any, of the primary hierarchy and the custom browse hierarchy represents a pared version of the primary hierarchy (col. 49-67).

Claim 21, Fohn discloses, A computer program product comprising: a computer-readable storage medium (col. 6, lines 7-11); and program instructions stored on said storage medium (col. 6, lines 34-50).

This independent claim is rejected for the similar rationale given above for claim 11.

Claims 12-20, 22, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,933,599) Nolan and (US 6,460,025) Fohn et al, hereafter Fohn as applied to claims 11 and 21above, and further in view of (US 6,466,918) Spiegel et al, hereafter Spiegel.

Claims 12 and 22, Nolan and Fohn failed to disclose, wherein, for each custom browse hierarchy, each item in the unique subset of items for the custom browse hierarchy is identified by a subset ID in a subset ID table and associated with each rule

met by the item, each of the items is stored in a database, and including the leaf node from the primary hierarchy in the custom browse hierarchy if the rule associated with the leaf node is included in the subset of rules and excluding the leaf node from the custom browse hierarchy if the rule associated with the leaf node is not included in the subset of rules further comprises: searching the database to identify each of the items in the database that meets the constraints of at least one rule; performing, for each of the items identified by searching the database, a table join between the identified item and the subset ID table to return a list of all subset IDs that are stored in an entry of the subset ID table with the identified item; and including the leaf node from the primary hierarchy in the custom browse hierarchy if the rule associated with the leaf node is identified in the subset ID table and excluding the leaf node from the custom browse hierarchy if the rule associated with the leaf node is not identified in the subset ID table.

Spiegel discloses, wherein, for each custom browse hierarchy, each item in the unique subset of items for the custom browse hierarchy is identified by a subset ID in a subset ID table (see table 2) and associated with each rule met by the item, each of the items (book titles) is stored in a database, and including the leaf node from the primary hierarchy in the custom browse hierarchy if the rule associated with the leaf node is included in the subset of rules and excluding the leaf node from the custom browse hierarchy if the rule associated with the leaf node is not included in the subset of rules (sites search engine col. 4, line 49) further comprises: searching the database to identify each of the items in the database that meets the constraints of at least one rule; performing, for each of the items identified by searching the database, a table join

between the identified item and the subset ID table to return a list of all subset IDs that are stored in an entry of the subset ID table with the identified item; and including the leaf node from the primary hierarchy in the custom browse hierarchy if the rule associated with the leaf node is identified in the subset ID table and excluding the leaf node from the custom browse hierarchy if the rule associated with the leaf node is not identified in the subset ID table (col. 7, lines 51 et.seq).

Claims 13 and 23. Nolan discloses, comprising: for each leaf node of the primary hierarchy: locating a next unprocessed leaf node of the primary hierarchy (Fig. 11 (1108)); for retrieving the returned list of all subset IDs for the next unprocessed leaf node (read as navigator 304 which displays child or unprocessed nodes); and for cloning the next unprocessed leaf node and its ancestors into the custom browse hierarchy if the subset ID identifying the unique subset is contained in the returned list of all subset IDs for the unprocessed leaf node. The step of cloning is interpreted as another term for copying a file and reproducing it in electronic form. The motivation for this step would be the use of ids rather than data which reduces the bandwidth usage and allows greater system capacity.

Claims 14 and 24. Nolan and Fohn failed to disclose, wherein searching the database further comprises: translating each rule to a database query; issuing the database query to a database server coupled to the database; executing the search in accordance with the database query; and performing the table join in accordance with the database query. Spiegel discloses, wherein searching the database further comprises: translating each rule to a database

query; issuing the database query to a database server coupled to the database; executing the search in accordance with the database query; and performing the table join in accordance with the database query (col. 4, lines 43-67- When the user selects a leaf category to view a corresponding list of book titles, the most popular book titles within that category may optionally be highlighted (not illustrated), such as by displaying them at the top of the list or in a particular color. Similarly, when the user selects a category that contains only leaf categories, the most popular leaf categories in the list may optionally be highlighted (not shown) in the same or similar manner).

Claims 15 and 25. Nolan and Fohn failed to disclose, wherein translating the search rule to a database query is performed by an application program being executed on an application server. Spiegel discloses, wherein translating the search rule to a database query is performed by an application program being executed on an application server (col. 4, lines 43-67- part of any search engine is the application program effecting the search).

Claim 16. Nolan failed to disclose, The method of Claim 12 wherein the items are products or services, and the items are represented by catalog data stored in the database, the catalog data comprising a unique product identifier, one or more attributes, a unique value for each of the attributes, and associated descriptive information. Fohn discloses, The method of Claim 12 wherein the items are products or services, and the items are represented by catalog data stored in the database, the catalog data comprising a unique product identifier, one or more attributes, a unique

value for each of the attributes, and associated descriptive information (col. 18, lines 17-54). Fohn is electronic catalog based with categories arranged hierarchically with sub-categories with attributes and values.

Claim 17. Nolan discloses, The method of Claim 11 wherein each of the unique subsets of items comprises a custom catalog, and wherein the custom browse hierarchy generated for each of the unique subsets is operable to browse the custom catalog (col. 2, lines 30-60)..

Claim 18. Nolan discloses, The method of Claim 12 further comprising:
identifying each custom browse hierarchy with the subset ID used to identify the unique subset for which the custom browse hierarchy is created and
for providing the custom browse hierarchy identified by the subset ID for display on a terminal having access to the database in response to a request identified by the subset ID (col. 8, lines 1-45- the shortcuts are made to web pages and the transferring the shortcuts to others).

Claim 19. Nolan discloses, The method of Claim 18 wherein said providing further comprises: for formatting the created custom browse hierarchy as one or more web pages; and for transmitting the web pages over the Internet for display on the terminal using a web browser (col. 16, lines 23-67).

Claim 20. Nolan discloses, The method of Claim 18 further comprising:
for formatting one or more copies of the created custom browse hierarchy; and
for exporting each formatted copy to an entity associated with the subset ID (col. 8, line

1-col. 9, line 59)..

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

January 29, 2009

